

REMARKS

By the foregoing amendments, Applicant has revised claims 17 and 56 to make them dependent on independent claims 14 and 53, respectively, and thereby overcome the Examiner's objections to those claims. Applicant thanks the Examiner for pointing out those claims' claim-dependency problem. Additionally, Applicant notes that claim 52 was inadvertently listed in the May 19, 2004, Response to Office Action as cancelled. However, Applicant did not intend to cancel this claim; Applicant did not identify this claim in the Remarks section of the May 19, 2004, Response as a claim that is to be canceled, nor did the Examiner record this claim as having been canceled. Accordingly, the text of the claim has been re-presented in this Amendment with the corresponding claim status of "Original."

Initially, Applicant would like to thank the Examiner for her courtesy in granting the telephone interview that occurred on December 6, 2004, between Examiner Robinson Boyce and Applicant's undersigned attorney. During that interview, Applicant's attorney explained that the prior art on which the Examiner relies merely describes ways of compiling prospective-customer lists; it does not, as Applicant's application does, describe how to select among existing lists. Applicant sets forth and expands upon that explanation below.

The Examiner has rejected independent claims 1, 9, and 14 and the claims that depend on them as defining subject matter obvious in view of U.S. Patent No. 5,636,346 to Saxe and in view of Heinly's "NAHB Conferees Explore Strategies to Cope with a Market Revolution." Applicant respectfully requests that the Examiner reconsider this rejection.

As explained during the December 6, 2004, interview, Applicant invented a system that enables advertisers to identify likely customers. Applicant's system identifies such likely customers by maintaining a customer-list database that keeps track of information such as which list each advertiser (referred to as a "list purchaser") has bought and which lists yielded good results for which advertisers. Using this information, Applicant's system

can help identify additional lists likely to be helpful to an advertiser that has bought a list. For example, Applicant's system can identify which other advertisers had previously used a list that one advertiser has used successfully, determine what other lists those other advertisers had used successfully, and, since advertisers in a particular industry or trade tend to target similar customers, recommend those lists (or lists based on them) to that first advertiser.

In contrast, the Saxe reference merely describes compiling a list from an already-selected list; it does not teach how to select the lists. Saxe describes a system that directs advertisements and marketing materials to cable-system subscribers (col. 1, lines 5-30). Specifically, the Saxe system maintains a database containing subscribers' identities and other relevant data such as their addresses, lifestyles, and demographic information (col. 5, lines 10-51). An authorized user of the Saxe system can prepare either a profile of the customers an advertiser wishes to reach or a list of the advertiser's current customers. That profile or list is used to produce a target listing of the cable-system subscribers that the advertiser can reach electronically.

But the Saxe system, unlike Applicant's, does not take characteristics of a customer list that a given advertiser has successfully used and employ them as a basis for identifying other lists with which the advertiser is likely to encounter success; it simply constructs a list of subscribers from its subscriber database. Nor does Saxe describe the claimed concept of associating prospect lists with data that are based on input from corresponding list purchasers and indicate whether such lists were successful for those list purchasers. Rather, as the Examiner recognized in the Office action (see, for example, page 3), Saxe discloses that targeted subscribers (or customers), not list purchasers, provide feedback regarding the marketing materials they received. That feedback does not indicate whether a customer list was successful for the advertisers; it is not the advertisers who provide the feedback. So the Saxe reference does not associate data from list purchasers with customer lists; it certainly does not associate with such lists data indicating whether particular lists are successful, as Applicant's claims 1, 9, and 14 require.

Nor does the Heinly reference teach such concepts. Heinly merely describes using old customer lists to construct new customer lists; he does not teach using old customer lists to identify other, already existing lists. Much less does he teach the use of an old list associated with one user to identify a list associated with a different user.

Accordingly, neither Saxe nor Heinly discloses or suggests the subject matter of Applicant's claims 1, 9, or 14. These claims and the claims that depend on them are therefore patentable over the prior art that the Examiner cited.

The Examiner has also rejected independent claim 53 and the claims that depend on it as defining subject matter that is obvious over Saxe in view of Heinly and further in view of U.S. Patent No. 6,004,276 to Wright. Applicant respectfully requests that the Examiner reconsider this rejection.

The Wright patent describes a clinical-information-reporting system for use with a health-care facility's electronic database. It does not deal with identifying customer lists, so it does not describe, for example, identifying additional successful customer lists by first identifying a list previously used successfully, identifying other list purchasers who have also used that list, and determining what other lists those other list purchasers have used successfully, as Applicant's claim 53 requires. As was explained above, Saxe and Heinly also do not teach this feature, either.

So neither Saxe nor Heinly nor Wright discloses or suggests the subject matter of Applicant's claim 53. This claim and the claims that depend on it are therefore patentable over the prior art of record.

The Examiner has also rejected claims 33 and 45 and the claims that depend on them as defining subject matter anticipated by the system described in Saxe. Applicant respectfully requests that the Examiner reconsider this rejection.

Applicant realized that another way of identifying potentially useful prospects lists for an advertiser who previously used a first list successfully is to determine whether any of

the customers appearing on the first successful list appears in other lists as well. This methodology enables an advertiser to base additional prospect-list selection on the theory that a list having customers in common with a list previously used successfully is likely to provide good results, too. Once such other lists are identified, they or lists based on them can be made available to the advertiser.

The Examiner argued that Saxe discloses the claimed feature of identifying at least one other prospect list that includes at least one of the customers that appeared in a first list. However, as Applicant explained above, Saxe does not tell how to identify lists; it merely tells how to construct a list from a list already identified. As Applicant also explained above, Saxe does not teach that lists in the database are associated with data provided by advertisers to indicate whether the advertisers encountered success with those lists. Rather, it is the customers themselves, as opposed to the advertisers, who provide Saxe's feedback.

So Saxe does not disclose or suggest the subject matter of Applicant's claims 33 and 45. These claims and the claims that depend on them are therefore patentable over Saxe.

Accordingly, Applicant asks that the Examiner reconsider and allow claims 1-14, 17, 18, 33-43, 45-53, 56 and 57.

Respectfully submitted,



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